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ELECTION

Atty. Docket No. 0509-1019

PATENTS

1635

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Christian BELMANT et al.

Confirmation No. 6944

Serial No. 09/786,055

GROUP 1635

Filed March 1, 2001

Examiner R. Schnizer

PHOSPHOEPOXIDES, PROCESS FOR THE
PRODUCTION THEREOF AND USE THEREOF

RESPONSE

Commissioner for Patents

Washington, D.C. 20231

Sir:

Responsive to the lack of unity determination set forth in the outstanding Official Action of August 27, 2002, applicants hereby provisionally elect Group I, claims 1-7 and 9-28, drawn to compositions comprising a phosphoepoxide of the formula shown in one of claims 1-5, comprising phosphodiester linkages, with traverse.

Responsive to the election of species requirement, applicants hereby provisionally elect the phosphoepoxides and epoxides as indicated on page 3 of the outstanding Official Action. It is respectfully submitted that claims 1-28 read on the elected species.

Applicants respectfully traverse the restriction and election of species requirements. Applicants request the examination of claims 1-28 in their full scope. The grounds for traverse are as follows:

Claims 1-28 pending in the present National Stage application were all subject to examination during the International Phase of the PCT application. The International Examiner found no lack of unity, applying the same legal standards to the identical facts. Therefore, the U.S. Patent and Trademark Office cannot now contend that examination of claims 1-28 in the present application would pose an undue searching burden. Indeed, the U.S. Examiner has the considerable benefit of the search results generated by the International Examiner, on the basis of the pending claims.

Furthermore, the Official Action does not comply with the requirements of PCT Rules 13.1 and 13.2, in seeking to justify the lack of unity determination. Specifically, the definition of "special technical feature" in PCT Rule 13.2 is art-based. The Examiner fails to provide any evidence showing that claims 1-28 do not relate to a single inventive concept. As the Examiner fails to provide this evidence, the lack of unity determination is improper as a matter of law. It is apparent that claims 1-28 share an extensive and detailed technical feature, which renders a lack of unity determination entirely inappropriate. Specifically, claims 1-28 all relate to phosphoepoxides of the depicted formula.

It is respectfully submitted that the election of species requirement is improper as a matter of law. It should be understood that the claimed compounds include a phosphoepoxide

group (see claim 1). The claimed compounds may also include an additional group, R2. As evidenced by claim 2, this additional group is a species itself. Applicants note that the Official Action therefore appears to impose an election of species requirement for this additional group. Thus, the Official Action actually imposes an election of species requirement upon an already existing species. As a result, the Official Action requires the election of a species from a species, or a "subspecies". It is respectfully submitted that this is improper as a matter of law and that the election of species requirement must be withdrawn.

In light of the above discussion, therefore, it is believed that applicants are entitled to an action on the merits of all of claims 1-28, in their full scope, in the present application. Such action is accordingly respectfully requested.

Respectfully submitted,

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